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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,547	06/26/2001	Kazuhiro Sugawara	35.C15492	9436
5514 7590 05/16/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NGUYEN, QUANG N	
			ART UNIT 2141	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/888,547

Applicant(s)

SUGAWARA ET AL.

Examiner

Quang N. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-49, 62, 63, 68 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-49, 62, 63, 68 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is responsive to the Amendment filed on 04/03/2007. Claims 1-43, 50-61, 64-67 and 70-73 have been cancelled. Claims 44-49, 62, 63, 68 and 69 have been amended and remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 44, 46-49, 62, 63, 68 and 69 are rejected under 35 U.S.C. 102(e) as being anticipated by Wakasugi et al. (US 6,823,367), hereinafter "Wakasugi".**

4. As to claim 44, **Wakasugi** teaches an image communicating apparatus (*NFA as illustrated in Fig. 1*) which is connected to a network capable of performing email communication, comprising:

a transmitting unit, adapted to send email data accompanied by an image file;

(Wakasugi, Fig. 1 and col. 6, lines 28-31 and lines 60-65);

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a receiving unit, adapted to receive email data (**Wakasugi, col. 6, lines 28-31**);

a requesting unit, adapted to add, selectively, information for requesting a message disposition notification to the email data to be sent to a receiver by the transmitting unit (*a request for an MDN message is made by adding a "Disposition Notification-To:" field to the header of an email to be transmitted to a receiver*) (**Wakasugi, Fig. 4 and col. 6, line 48 – col. 7, line 10**);

a communication managing unit, adapted to manage transmission management information of the sent email data (**Wakasugi, Fig. 8 and col. 8, lines 37-67**);

an analyzing unit, adapted to analyze how the transmission of the sent email data to which the information for requesting the message disposition notification was added was processed by the receiver, based on the message disposition notification included in the email data received by the receiving unit (*as illustrated in Fig. 5 "Disposition manual-action/MDN-send-Manually; displayed" is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit*) (**Wakasugi, Fig. 5 and col. 7, lines 11-20 and lines 37-47**);

a judgment unit, adapted to judge whether or not a result of the transmission of the sent email data to which the information for requesting the message disposition notification was added succeeded, based on an analysis result by the analyzing unit (*as illustrated in Fig. 5 "Disposition manual-action/MDN-send-Manually; displayed" is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit and in this case, the sent email data was properly received and*

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displayed) (**Wakasugi, Fig. 5 and col. 7, lines 11-20 and lines 37-47 and col. 9, lines 46-60**); and

a notifying unit, adapted to notify a user of the image communicating apparatus based on the transmission management information managed by the communication managing unit (**Wakasugi, Fig. 12 and col. 9, line 65 – col. 10, line 3**),

wherein the communication managing unit updates the transmission management information by information showing whether or not the transmission of the sent email data succeeded, on the basis of a judged result provided by the judgment unit (*the NFA detects the delivery confirmation mail sent from the NFB at step 104 and executes the reception process of the delivery confirmation mail at step 105 and as illustrated in Fig. 5 “Disposition manual-action/MDN-send-Manually; displayed” indicates that the sent email data was properly received and displayed, the NFA changes “—” to “OK” in the result field of the communication management information recorded in the communication management table 4a*) (**Wakasugi, col. 9, lines 45-60**), and

wherein the notifying unit notifies the user of the image communicating apparatus whether or not the transmission of the sent email data succeeded, on the basis of the updated transmission management information, so that a user of the image communicating apparatus can confirm whether or not transmission of the sent email data succeeded, without reading the message disposition information (**Wakasugi, Fig. 12 and col. 9, line 65 – col. 10, line 3**).

5. As to claim 46, **Wakasugi** teaches the image communicating apparatus of claim 44, wherein the communication managing unit updates the transmission management information to first information, showing that the message disposition notification responsive to the sent email data has been received (*the NFA detects the delivery confirmation mail sent from the NFB at step 104 and executes the reception process of the delivery confirmation mail at step 105 and as illustrated in Fig. 5 "Disposition manual-action/MDN-send-Manually; displayed"* of the delivery confirmation mail indicates that the sent email data was properly received and displayed, the NFA changes "—" to "OK" in the result field of the communication management information recorded in the communication management table 4a) (**Wakasugi, col. 9, lines 45-60**).

6. As to claim 47, **Wakasugi** teaches the image communicating apparatus of claim 44, wherein the communication managing unit updates the transmission management information to second information (*user code recorded*), showing that the message disposition notification responsive to the sent email data was not received within a predetermined period of time (*12 hours*) (**Wakasugi, col. 14, line 48 – col. 15, line 34**).

7. As to claim 48, **Wakasugi** teaches the image communicating apparatus of claim 44, wherein the notifying unit visually outputs the transmission management information which is managed by the communication managing unit (**Wakasugi, col. 13, line 66 – col. 14, line 3**).

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8. As to claim 49, **Wakasugi** teaches an image communicating apparatus (*NFA as illustrated in Fig. 1*) which is connected to a network capable of performing email communication, comprising:

a transmitting unit, adapted to send email data accompanied by an image file;
(Wakasugi, Fig. 1 and col. 6, lines 28-31 and lines 60-65);

a receiving unit, adapted to receive email data **(Wakasugi, col. 6, lines 28-31);**

a requesting unit, adapted to add, selectively, information for requesting a message disposition notification to the email data to be sent to a receiver by the transmitting unit **(Wakasugi, Fig. 4 and col. 6, line 48 – col. 7, line 10);**

an analyzing unit, adapted to analyze how the transmission of the sent email data to which the information for requesting the message disposition notification was added was processed by the receiver, based on the message disposition notification included in the email data received by the receiving unit (*as illustrated in Fig. 5 “Disposition manual-action/MDN-send-Manually; displayed” is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit*) **(Wakasugi, Fig. 5 and col. 7, lines 11-20 and lines 37-47);**

a judgment unit, adapted to judge whether or not a result of the transmission of the sent email data to which the information for requesting the message disposition notification was added succeeded, based on an analysis result by the analyzing unit (*as illustrated in Fig. 5 “Disposition manual-action/MDN-send-Manually; displayed” is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit and in this case, the sent email data was properly received and*

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displayed) (Wakasugi, Fig. 5 and col. 7, lines 11-20 and lines 37-47 and col. 9, lines 46-60); and

a notifying unit, adapted to be able to notify whether or not the transmission of the sent email data succeeded, based on a judged result by the judgment unit, without reading the message disposition notification by a user of the image communication apparatus (*the NFA detects the delivery confirmation mail sent from the NFB at step 104 and executes the reception process of the delivery confirmation mail at step 105 and as illustrated in Fig. 5 "Disposition manual-action/MDN-send-Manually; displayed" indicates that the sent email data was properly received and displayed, the NFA changes "—" to "OK" in the result field of the communication management information recorded in the communication management table 4a*) (Wakasugi, Figs. 12 and 17, col. 9, line 45 – col. 10, line 3).

9. Claims 62-63 and 68-69 are corresponding method and computer readable storage medium claims of apparatus claims 44 and 49; therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

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are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 44, 49, 62-63 and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwazaki (US 6,687,742), in view of Wakasugi (US 6,823,367).

12. As to claim 44, Iwazaki teaches an image communicating apparatus, comprising:
a transmitting unit, adapted to send email data accompanied by an image file
(Internet facsimiles 3 and 8 have both units functioning in transmission/reception emails with attached image) (Iwazaki, col. 4, line 56 – col. 5, line 4);

a receiving unit, adapted to receive email data *(Internet facsimiles 3 and 8 have both units functioning in transmission/reception emailswith attached image) (Iwazaki, col. 4, line 56 – col. 5, line 4);*

a requesting unit, adapted to add, selectively, information for requesting a message disposition notification "MDN" to the email data to be sent to a receiver by said transmitting unit *(a request for an MDN message is made by adding a "Disposition Notification-To:" field to the header of an email to be transmitted to a receiver) (Iwazaki, Fig. 4 and col. 6, lines 39-48);*

a communication managing unit, adapted to manage transmission management information of the sent email data *(the processing result from the MDN response message is recorded in transmission history information) (Iwazaki, col. 7, lines 61-64);*

an analyzing unit, adapted to analyze how the transmission of the sent email data to which the information for requesting the message disposition notification was

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added was processed by the receiver, based on the message disposition notification included in the email data received by the receiving unit (as illustrated in Fig. 6 ***“Disposition: automatic-action/MDN-send-automatically; dispatched”*** and as illustrated in Fig. 11 ***“Disposition: automatic-action/MDN-send-automatically; processed/warning”*** is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit) (Iwazaki, Figs. 6 and 11 and col. 7, line 11 – col. 8, line 12, col. 10, lines 17-26 and col. 12, lines 57-67);

a judgment unit, adapted to judge whether or not a result of the transmission of the sent email data to which the information for requesting the message disposition notification was added succeeded, based on an analysis result by the analyzing unit (as illustrated in Fig. 6 ***“Disposition: automatic-action/MDN-send-automatically; dispatched”*** and as illustrated in Fig. 11 ***“Disposition: automatic-action/MDN-send-automatically; processed/warning”*** is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit and in this case, the sent email data was properly received and dispatched and/or processed) (Iwazaki, Figs. 6 and 11 and col. 7, line 11 – col. 8, line 12, col. 10, lines 17-26 and col. 12, lines 57-67); and

wherein the communication managing unit updates the transmission management information by information showing whether or not the transmission of the sent email data succeeded, on the basis of a judged result provided by the judgment unit (the sender records the processing result in the returned MDN message in the

transmission history information) (**Iwazaki**, col. 7, lines 61-64 and col. 13, lines 45-55).

However, **Iwazaki** does not explicitly teach a notifying unit notifies the user of said image communicating apparatus whether or not the transmission of the sent email data succeeded, on the basis of the updated transmission management information, so that the user of said image communicating apparatus can confirm whether or not the transmission of the sent email data succeeded, without reading the message disposition information.

In an analogous art, **Wakasugi** discloses a system and method of allowing user to browse the history of transmission on data terminal, wherein the network facsimile device NFA has an ability to output the communication management information in the form of a communication management report which is created and outputted based on the recorded contents of the communication management table 4a shown in Fig. 8 (*the NFA detects the delivery confirmation mail sent from the NFB at step 104 and executes the reception process of the delivery confirmation mail at step 105 and as illustrated in Fig. 5 "Disposition manual-action/MDN-send-Manually; displayed" indicates that the sent email data was properly received and displayed, the NFA changes "—" to "OK" in the result field of the communication management information recorded in the communication management table 4a*) (**Wakasugi**, Figs. 8-9, 12 and 17, col. 9, lines 12-36 and col. 9, line 65 – col. 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the Data Processing Art at the time the invention was made to incorporate the feature of notifying

the user of said image communicating apparatus so that the user can confirm whether or not the transmission of the sent email data succeeded, without reading the message disposition information, as disclosed by **Wakasugi**, into the teaching of **Iwazaki**, since both references are directed to electronic message processing systems, hence, would be considered to be analogous based on their related fields of endeavor.

One would be motivated to do so to allow the communications system to inform the sending user the status of the delivery of the message.

13. Claim 49 contains similar limitations as claim 44; therefore, it is rejected under the same rationale.

14. Claims 62-63 and 68-69 are corresponding method and computer readable storage medium claims of apparatus claims 44 and 49; therefore, they are rejected under the same rationale.

15. Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwazaki, in view of Wakasugi, and further in view of Miyamoto et al. (US 6,327,046), hereinafter "Miyamoto".

16. As to claim 45, **Iwazaki-Wakasugi** teaches the apparatus of claim 44, but does not explicitly teach a selecting unit, adapted to select ON/OFF of an execution of said requesting unit, wherein said communication managing unit manages ON/OFF of the

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request of the message disposition notification as transmission information for every sent email.

In an analogous art, **Miyamoto** teaches an electronic mail processing apparatus and method comprising a selecting part for selecting whether a request for reply to an electronic mail to be transmitted is to be made or not by marking the check box 19 in Fig. 5 to turn ON a reply email request (Miyamoto, Fig. 5 and col. 6, lines 16-32). **Miyamoto** also teaches that if a reply from the receiver of the email has been sent, the task finish flag 11-4-5 in the Todo task list storage section 11-4 of the RAM 11 is set to be "1" (*i.e., update the transmission information on the basis of whether or not said requesting unit requests the reply email responsive to the sent email*) (**Miyamoto, col. 6, line 62 – col. 7, line 18**).

Therefore, it would have been obvious to one having ordinary skill in the Data Processing Art at the time the invention was made to incorporate the feature of a selecting unit, adapted to select and manage ON/OFF of the request of the message disposition notification as transmission information for every sent email, as disclosed by **Miyamoto**, into the teachings of **Iwazaki-Wakasugi**, since references are directed to electronic message processing systems, hence, would be considered to be analogous based on their related fields of endeavor.

One would be motivated to do so to allow the sender to select whether a request for reply to an email from the receiver to be made or not at the time of transmitting the email and to specify a due date of reply and to retransmit the same email automatically when no reply has been received within a predetermined period of time.

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17. As to claim 46, **Iwazaki-Wakasugi-Miyamoto** teaches the apparatus of claim 44, wherein said communication unit updates the transmission information to first information showing that the message disposition notification responsive to said sent email data has been received (*i.e., the task finish flag 11-4-5 is set to "1", the item is displayed as a processed task with a check mark*) (**Miyamoto, Figs. 7-8, col. 7, lines 6-18 and col. 8, lines 19-32**). The same motivations regarding the obviousness of claim 45 would be applied equally well to claim 46.

18. As to claim 47, **Iwazaki-Wakasugi-Miyamoto** teaches the apparatus of claim 44, wherein said communication unit updates the transmission information to second information showing that the message disposition notification responsive to the sent email data was not received within a predetermined period of time (*i.e., the task finish flag is set to "0", the item is displayed as an unprocessed task*) (**Miyamoto, Figs. 7-8 and col. 7, lines 6-21**). The same motivations regarding the obviousness of claim 45 would be applied equally well to claim 47.

19. As to claim 48, **Iwazaki-Wakasugi-Miyamoto** teaches the apparatus of claim 44, wherein said notifying unit visually outputs the transmission management information, which is managed by said communication managing unit (**Wakasugi, Figs. 8-9, 12 and 17, col. 9, lines 12-36 and col. 9, line 65 – col. 10, line 3**).

Conclusion

20. Applicant's arguments as well as request for reconsideration filed on 04/03/2007 have been fully considered but they are moot in view of the new ground(s) of rejection.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quang N. Nguyen
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